



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,574	11/21/2001	Pravin T.P. Kaumaya	18525/04028	2019

24024 7590 07/10/2006

CALFEE HALTER & GRISWOLD, LLP
800 SUPERIOR AVENUE
SUITE 1400
CLEVELAND, OH 44114

EXAMINER

OUSPENSKI, ILIA I

ART UNIT	PAPER NUMBER
----------	--------------

1644

DATE MAILED: 07/10/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/990,574	Applicant(s) KAUMAYA ET AL.	
	Examiner ILIA OUSPENSKI	Art Unit 1644	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1,3-6,10,13,17,18,20,26 and 27 is/are pending in the application.
- 4a) Of the above claim(s) 17,18,20,26 and 27 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,3-6,10 and 13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Applicant's amendment/remarks, filed 05/11/2006, are acknowledged.

Claims 2, 7-9, 11, 12, 14-16, 19, 21-25, and 28-32 have been cancelled previously.

Claims 1, 3-6, 10, 13, 17, 18, 20, 26, and 27 are pending.

Claims 17, 18, 20, 26, and 27 have been withdrawn from consideration by the Examiner as being drawn to nonelected inventions.

Claims 1, 3 – 6, 10, and 13 are under consideration in the instant application.

2. This Office Action will be in response to applicant's amendment and arguments, filed 05/11/2006.

The rejections of record can be found in the previous Office Action, mailed 02/14/2006.

The text of those sections of Title 35 USC not included in this Action can be found in a prior Office Action.

3. The Declaration under 37 CFR1.131 by Dr. Pravin T.P. Kaumaya, filed on 05/11/2006, is acknowledged, and has been entered.

Art Unit: 1644

4. Claims 1, 3 – 6, 10, and 13 stand rejected under **35 U.S.C. 102(a)** as being anticipated by Srinivasan et al. (1999, reference AK on IDS filed 03/24/2003; see entire document), as evidenced by the instant specification on page 14.

Applicant's arguments have been fully considered but have not been found convincing.

Applicant relies on the Declaration under 37 CFR 1.131 by Dr. Pravin T.P. Kaumaya, filed on 05/11/2006, stating that the information described by Srinivasan et al. was created in the United States prior to the publication of the reference.

This has not been found persuasive, at least for the following reasons.

I. Applicant asserts that the reference is part of the book, *Peptides for the New Millennium*, published in August 2000, i.e. less than one year prior to the filing date of the instant application.

However, as discussed in the previous Office Action, the reference provides *prima facie* evidence that the invention was known or used by others in this country as early as June 26, 1999, i.e. more than one year prior to the filing date of the instant application. Affidavits or declarations under 37 CFR 1.131 are inappropriate to antedate evidence that the invention was known or used by others in this country more than one year prior to applicant's effective filing date.

II. The evidence submitted is insufficient to establish a conception of the invention prior to the effective date of the reference. While conception is the mental part of the inventive act, it must be capable of proof, such as by demonstrative evidence or by a complete disclosure to another. Conception is more than a vague idea of how to solve a problem. The requisite means themselves and their interaction must also be

Art Unit: 1644

comprehended. See Mergenthaler v. Scudder, 1897 C.D. 724, 81 O.G. 1417 (D.C. Cir. 1897).

Furthermore, the evidence submitted is insufficient to establish diligence from a date prior to the date of the reference to either a constructive reduction to practice or an actual reduction to practice.

The Declaration presents an assertion that “the retro-inverso peptide analog [...] was created in the United States prior to publication of the book section. The rule requires that copies of drawings or other records must accompany and form part of the affidavit or declaration or their absence satisfactorily explained. A mere statement that the invention was reduced to practice or that the applicant exercised due diligence is not sufficient to satisfy the rule. Applicant must provide more evidence to overcome the date of the reference.

III. The Declaration does not address the issue of *prima facie* evidence that the invention was known or used by others, as discussed in the previous Office Action. In particular, the reference co-author R. Wardrop, who is not a co-inventor of the instantly claimed subject matter, was in possession of the claimed peptide analog prior to the filing date of the instant application, is assumed not to be bound by a confidentiality obligation, and at liberty to disclose the sequence of the claimed peptide analog to others.

IV. The Declaration is defective because: it is signed by just one inventor, Dr. Kaumaya. There are three co-inventors of the current application, and there is no evidence on record to show that Dr. Kaumaya is the sole inventor of the subject matter of the rejected claims. See MPEP 715.04.

5. Conclusion: no claim is allowed.

7. THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to ILIA OUSPENSKI whose telephone number is 571-272-2920. The examiner can normally be reached on Monday-Friday 9 - 5.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christina Chan can be reached on 571-272-0841. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

Art Unit: 1644


you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

ILIA OUSPENSKI, Ph.D.

Patent Examiner

Art Unit 1644

June 29, 2006


PHILLIP GAMBEL, PH.D. . JD.
PRIMARY EXAMINER
R 1600
7/2/06